

REMARKS

In the application claims 7-10 and 13-27 remain pending. Claims 1-6 and 11-12 have been canceled without prejudice.

All of the pending claims presently stand rejected. The reconsideration of the rejection of the claims is respectfully requested.

In the Office Action, the pending claims were rejected under 35 U.S.C. § 103 as being rendered obvious primarily by Allport (U.S. Patent No. 6,104,334) in view of Takechi (U.S. Patent No. 6,104,334) in further view of Kelly (U.S. Patent No. 5,907,322). In rejecting the claims, the Office Action asserted that Allport teaches entering into a hand-held device data that functions to identify a consumer appliance and using the data at the Web server to retrieve an electronic document (IR command library) for the purpose of operating the consumer appliance and that Takechi teaches an electronic document comprising human-readable information describing how to interact with one or more controls of the consumer appliance for the purpose of operating the consumer appliance. While the Office Action acknowledged that both Allport and Takechi fail to disclose uploading the data that functions to identify the consumer appliance from the hand-held device to a Web server and using the data that functions to identify the consumer appliance, the Office Action asserted that Kelly discloses, in Fig. 1 (items 62,21) and Col. 7, lines 11-25, uploading data that functions to identify the consumer appliance from a device to a Web server and using the data that functions to identify the consumer appliance. Thus, the Office Action concluded that it would have been obvious to modify the combined Takechi and Allport system “in order to allow the viewer to easily access URLs.”

In response to this rejection, it is respectfully submitted that a rejection under 35 U.S.C. § 103 requires, among other things, that each and every element set forth in the claims be found,

either expressly or inherently, in the references being relied upon. In addition, when assessing the patentability of a claimed invention, it is impermissible to break an invention into its component parts and then find a reference containing one part, another reference containing another part, etc., while using the specification of the Applicant as a template to combine these parts for the purpose of deprecating that claimed invention. Thus, to assure that such “hindsight reasoning” is not used, a rejection under 35 U.S.C. § 103 also requires a demonstration that an artisan of ordinary skill in the art at the time of the invention, with no knowledge of the claimed invention, would have selected the various parts from the references and combined them in the manner claimed.

Turning first to Allport, it is first respectfully submitted that Allport fails to disclose “entering into a hand-held device data that functions to identify a consumer appliance” and “using the data at the Web server to retrieve an electronic document (IR command library) for the purpose of operating the consumer appliance” as set forth in the rejection of the claims. That Allport fails to disclose this claimed element is later acknowledged *when the Office Action sets forth* that “Allport and Takechi et al. do not show uploading the data that functions to identify the consumer appliance from the hand-held device to a Web server, using the data that functions to identify the consumer appliance.” Since Allport therefore fails to expressly describe, teach, or suggest the claimed causing data that functions to identify a consumer appliance to be uploaded from a hand-held device to a Web server or using the uploaded data to retrieve an electronic document for the consumer appliance identified by the data, Allport fails to disclose the very base elements that the rejection of the claims proposes to modify. For this reason, a *prima facie* case of obviousness has not been established and the rejection of the claims must be withdrawn.

Considering now Kelly, while the disclosure within Kelly, namely Col. 7, lines 11-25, may use the word “upload,” nothing from within Kelly can be said to suggest uploading to a Web server the specifically recited “data that functions to identify an appliance” and using the same for any purpose. Rather, Kelly describes in Col. 7, lines 11-25 nothing more than uploading channel selection data to thereby address the problem of how to identify patterns in TV viewing, such as frequency of viewing of particular channels, broadcast events, volume patterns and other events and patterns. Thus, not only does Kelly fail to describe that which is missing from Allport and Takechi, it cannot even be said that Kelly is relevant to the problems the claimed invention overcomes. Furthermore, even if one were motivated to modify the combined system of Allport and Takechi “to allow the viewer to easily access URLs” as alleged in the Office Action (which motivation itself could not possibly lead one of ordinary skill in the art to the invention claimed), one would still only arrive at a system that uploads channel selection data which is the **only** uploading that is described in the cited passage of Kelly. One of ordinary skill in the art would not, however, be led by the teachings within Kelly to modify the combined system of Allport and Takechi (which combination still fails to include the remaining elements set forth in the claims) to upload data to a Web server that functions to identify an appliance and using the same for the simple reason that Kelly never discloses, teaches, suggests, or even infers the desirability of this claimed concept. Thus, it is respectfully submitted that the teachings within Kelly cannot be said to demonstrate that that an artisan of ordinary skill in the art at the time of the invention, with no knowledge of the claimed invention, would have selected the various parts from the references and combined them in the manner claimed. For this reason it is submitted that the rejection under 35 U.S.C. § 103 must be withdrawn.

CONCLUSION

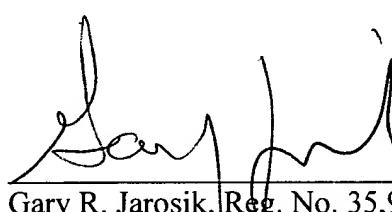
It is respectfully submitted that the application is in good and proper form for allowance. Such action of the part of the Examiner is respectfully requested. Should it be determined, however, that a telephone conference would expedite the prosecution of the subject application, the Examiner is respectfully requested to contact the attorney undersigned.

The Commissioner is authorized to charge any fee deficiency or credit overpayment to deposit account 50-2428 in the name of Greenberg Traurig.

Respectfully Submitted;

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